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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,750	06/24/2003	Peter J. Dix	17333	1002
37414	7590	03/30/2005	EXAMINER	
CNH AMERICA LLC INTELLECTUAL PROPERTY LAW DEPARTMENT PO BOX 1895, MS 641 NEW HOLLAND, PA 17557			HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/602,750	DIX ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edwin C. Holloway, III	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 June 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11-28-03, 3-10-04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

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***EXAMINER'S RESPONSE***

1. In response to the application filed 6-24-03, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 24-26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 is confusing because it refers to claim 1 as a system, but claim 1 is direct to a method. It is suggested that claim 24 be amended to depend from claim 19. Claim 25 is unclear because it refers to "the transponder" in line 2 and then to "a transponder" in line 3. Placing the phrase that includes the "a transponder" language prior to the phrase that contains the "the transponder" language would clarify this matter.

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***Claim Rejections - 35 USC § 102 & 103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1-3, 5-10, 12-16, 18-22 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi (US 5912512A). Regarding claim 1, Hayashi discloses smart (transponder) key programming method with inserting and detecting of master key in

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steps 104-114 of fig. 3, col. 6 line 66 and col. 7 lines 48-56.

If the master key is detected, the vehicle is placed in the programming mode or registration processing as step 120 in col. 7 lines 57-67. A second key is inserted and read in step 122 and col. 8 lines 1-5. The vehicle and second key are configured to allow subsequent starting of the vehicle by registering the code of the second key in step 128 and col. 8 lines 31-46.

Claims 12-13 generally correspond to the method of claim 1 with the addition of substantially simultaneously programming the vehicle and a prior operating key to deny access that is provided by the Hayashi disclosing, in addition to the limitations discussed above, that the final code is rewritten in col. 8 line 35-45 that would cause vehicle to prohibit operation if the prior key is inserted in step 314. Claim 19-20 include a system with structure to provide the steps of claim 1 that is anticipated by Hayashi disclosing structure in fig. 1 that provides the steps applied above to claim 1. Regarding claims 2-3, 14 and 22, Hayashi discloses exiting the programming mode after predetermined time in steps 126 and 116. Regarding claims 5-8, 15-16 and 21, Hayashi includes visual or light indication of programming mode or registration process in steps 120 and 130, col. 7 lines 61-67 and col. 8 lines 44-46. Regarding claims 9-10 and 27-28, disabling a prior operating key is

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anticipated for the reasons applied above to claims 12-13.

Regarding claim 18, rewriting no. 3 code col. 8 lines 31-41 of Hayashi requires a third operator key.

8. Claims 4, 11, 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US 5912512A) as applied above in combination with Lambropoulos (US 4881148). Regarding claims 4 and 23, Lambropoulos discloses a vehicle programming system with extending the programming time for input of additional codes in fig. 3 and col. 15 lines 20-25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included to time extending of Lambropoulos in the invention of Hayashi in order to allow sufficient time to program the desired number of codes.

Regarding claims 11 and 29, the writing operation of Lambropoulos will overwrite all prior codes in all registers to allow indication of unauthorized programming or tampering in col. 14 lines 35-56. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the multiple code overwrite of Lambropoulos in the invention of Hayashi to indicate tampering.

9. Claims 11, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US 5912512A) as applied above in combination with Enoyoshi (US 6525433B1). Regarding

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claims 11 and 29, Enoyoshi discloses erasing multiple prior codes with the master key in col. 4 lines 60-65 and col. 6 lines 9-10 to prevent use of lost or mis-registered keys. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the multiple code erasing of Enoyoshi in the invention of Hayashi to prevent use of multiple lost or mis-registered keys. Regarding claims 24-26, Enoyoshi discloses a key with mechanical coding 14 and mounted or molded transponder 15 in fig. 1 and col. 2 line 62 - col. 3 line 40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the above structure of Enoyoshi in the key of Hayashi in order to provide both mechanical tumbler and digital code security.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US 5912512A) as applied above in combination with Mutoh (US 5621380A). Mutoh discloses an analogous art vehicle antitheft system with mode lamp turned off at the exit of programming in col. 5 lines 28-47 and it would have been obvious to have included this turning off step in the invention of Hayashi so that the user can recognize that the vehicle has exited programming mode.

11. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being

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unpatentable over Hayashi (US 5912512A) as applied above in combination with Hasegawa (US 5635900). Regarding claims 24-26, Hasegawa discloses a key with mechanical coding 4 and mounted or molded transponder 4a in fig. 2 and col. 3 lines 21-43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the above structure of Hasegawa in the key of Hayashi in order to provide both mechanical tumbler and digital code security.

#### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iwamoto (US 6133649A) and Honda (US 6160488A) disclose vehicle antitheft systems with transponder key programming.

#### ***CONTACT INFORMATION***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

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Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH  
3/19/05



**EDWIN C. HOLLOWAY, III**  
**PRIMARY EXAMINER**  
**ART UNIT 2635**